

24. [Amended] An apparatus for controlling access to information based on content of the information and user identity comprising:

display means;

user-recognition input means for determining which users are present in a given area having access to the display and for providing one or more values that correspond to the identities of the users;

memory means for storing information that identifies a video content that is being displayed on the video display, and information specifying which users are to be permitted access to that content;

processor means for comparing a user-identity value from the input means to the memory means information specifying [which specifies] which users are to be permitted access to that content and for producing an access-allowed indication based on that comparison; and

blocking means coupled to the processor for selectively blocking display of the content based on the access-allowed indication.

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on May 24, 2002, and the references cited therewith.

Claims 7 and 24 have been amended to merely attend to minor typographical errors and not to affect the patentability of such claims. Claims 1-29 are now pending in this application.

§102 Rejection of the Claims

Claims 1-3, 6-8, 10-11, 13-14, 16-17, 19-21, 24-25 and 27-28 were rejected under 35 USC § 102(e) as being anticipated by Williams (US 5,977,964). This rejection is respectfully traversed at least on the basis that Williams does not show each and every element of the claims.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art

reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because at least one element is not shown in Williams.

Claim 1 recites “a user-recognition input device that **determines whether an additional user is newly present in a given area** having access to the display”. The Office action indicates that Williams discloses a user recognition input device in Figure 1 (118, 120), Figure 7 (706), and as described in column 11, lines 2-21. In association with such description of Williams, Williams then provides the following explanation of the functions performed by a camera and microphone: “Having determined **which user** of a plurality of entertainment system users is currently using system 10, system controller 104, in one embodiment, **presents the user** with a number of programming suggestions which most closely align with the user profile **of the particular user...**” Col. 11, lines 22-26 (emphasis added). Thus, Williams is directed toward interfacing with a single user at a time, and recognizing the single user. Claim 1 is directed toward determining whether an additional user is newly present in a given area and controlling display of information based on that determination. Williams does not detect additional users. Further, recognition is triggered when “the user speaks into a microphone of system 100 (e.g., to activate system 100).” Col. 11, lines 2-4. Williams does not determine if an additional user is newly present. There is no concept of an additional user, only a new user. Further, it does not provide the function of detecting users in a given area. Still further, it does not control the display of information based on who is in a given area, such as a room where one can see the display. Any one of these distinctions should be sufficient for establishing lack of anticipation.

The rejection of claim 1 does not address the functions performed that are clearly recited with each element. Functional language is specifically authorized by *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971); *In re Caldwell*, 138 USPQ 243 (CCPA 1963); *Lewmar*

Marine, Inc. v. Barient, Inc., 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987); MPEP § 2173.05(g). As such, a prima facie case of anticipation has not been established.

Claim 2 depends from claim 1, and is patentable for at least the same reasons. Further, the characterization of Figure 2 containing (NEW USERS DETECTED?) is respectfully traversed. USERS is not plural in Figure 2. The correct phrase is (NEW USER DETECTED?). This further supports applicant's reading of Williams as only dealing with one user at a time, and not an additional user. Claims 3-6 also depend from claim 1, and distinguish Williams for at least the same reasons.

Independent claim 7 contains much functional language that has not been addressed in the Office Action. Claim 7 refers to "determines which users are present in a given area", "which users are permitted access to that content", and "blocks display of the content based on the access-allowed indication." Williams is not cited as containing apparatus performing any of these functions. Hence, a prima facie case of anticipation has not been established, and the rejection should be withdrawn.

Claims 8-12 depend from claim 7 and distinguish from Williams for at least the same reasons.

Independent claim 13 contains much functional language that has not been addressed in the Office Action. Claim 13 refers to "determining that a user is present in a given area", "which users are permitted access to that content", and "controlling display of the content based on the access-allowed indication." Williams is not cited as containing apparatus performing any of these functions. Hence, a prima facie case of anticipation has not been established, and the rejection should be withdrawn.

Claims 14-18 depend from claim 13 and distinguish for at least the same reasons.

Independent claim 24 contains much functional language that has not been addressed in the Office Action. Claim 24 refers to "determining which users are present in a given area", "which users are permitted access to that content", and "selectively blocking display of the content based on the access-allowed indication." Williams is not cited as containing apparatus performing any of these functions. Hence, a prima facie case of anticipation has not been

established, and the rejection should be withdrawn.

Claims 25-29 depend from claim 24 and distinguish for at least the same reasons.

Independent claim 19 also refers to "determining that an additional user is new present in a given area", which is not shown by Williams as discussed with respect to the rejection of claim 1 and incorporated herein. Further, claim 19 contains the element "selectively blocking output of the information based on whether the additional user is new present". As discussed above, there is no concept of an additional user in Williams, only a new user for a system that has a single user at any given time.

§103 Rejection of the Claims

Claims 4, 12, 18, 22 and 29 were rejected under 35 USC § 103(a) as being unpatentable over Williams (US 5,977,964) in view of Lu (US 5,771,307). The rejection is respectfully traversed.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for the following reasons:

(1) Even if combined, the cited references fail to teach or suggest all of the elements of applicant's claimed invention. The remarks with respect to the §102 rejection of these claims establish several elements that are lacking in Williams. Lu is not represented in the Office Action as providing them. Thus, a *prima facie* case of obviousness has not been established, and the rejection should be withdrawn.

(2) Evidence for a suggestion to combine is not of record. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). The Office Action stated "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Williams to include a motion sensor, as disclosed by Lu, to increase reliability, and accuracy of detection of viewers entering or leaving the viewing area." which is a mere conclusory statement of subjective belief, so Applicant respectfully submits that

the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Claims 5 and 23 were rejected under 35 USC § 103(a) as being unpatentable over Williams (US 5,977,964) in view of Wachob (US 5,231,494). This rejection is respectfully traversed.

The remarks with respect to the §102 rejection of these claims establish several elements that are lacking in Williams. Wachob is not represented in the Office Action as providing them. Thus, a prima facie case of obviousness has not been established, and the rejection should be withdrawn. Further, there is no objective evidence of record for a suggestion to combine Williams and Wachob.

Claims 9, 15 and 26 were rejected under 35 USC § 103(a) as being unpatentable over Williams (US 5,977,964) in view of Kipust (US 6,002,427). This rejection is respectfully traversed.

The remarks with respect to the §102 rejection of these claims establish several elements that are lacking in Williams. Kipust is not represented in the Office Action as providing them. Thus, a prima facie case of obviousness has not been established, and the rejection should be withdrawn. Further, there is no objective evidence of record for a suggestion to combine Williams and Kipust.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6972) to facilitate prosecution of this application.

AMENDMENT AND RESPONSE UNDER 37 CFR 1.111

Serial No.: 09/211,730

Filed: December 15, 1998

Title: APPARATUS AND METHOD FOR USER-BASED CONTROL OF TELEVISION CONTENT

Page 8

Docket: 450.241US1

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

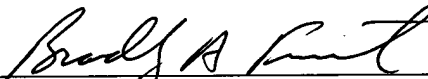
KEITH C. THOMAS

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6949

Date 9-13-2002

By



Bradley A. Forrest

Reg. No. 30,837

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 13 day of September 2002.

Candis B. Buending

Name

Signature

